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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,187	02/05/2004	Joe A. Wright	4688 (OSI0054/US/8)	7196

7590 10/04/2006

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EXAMINER	
CHEN, VIVIAN	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,187	WRIGHT ET AL.	
	Examiner	Art Unit	
	Vivian Chen	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/091,754, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Therefore, for the purposes of this Office Action:

Claims 1-7, 12-22 are deemed to have a filing date of **02/05/2004**.

Claims 8-11 are deemed to have an effective filing date of **03/05/1998**.

Terminal Disclaimer

2. The terminal disclaimers filed on 6/30/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of:

(a) U.S. Patent Nos. 6,686,051 and 6,383,651 and 6,423,418; and

(b) patents issuing from copending Application No. 10/966,528 (US 2005/0048213);

have been reviewed and is accepted. The terminal disclaimer has been recorded.

3. The double patenting rejections based on:

(a) U.S. Patent Nos. 6,686,051 and 6,383,651 and 6,423,418; and

(b) copending Application No. 10/966,528 (US 2005/0048213);

have been withdrawn in view of the Terminal Disclaimers filed 6/30/2006.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-22 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-88 of U.S. Patent No. 6,660,828, for the reasons stated in the previous Office Action.

The above Patent claims curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and/or methods of forming such coated substrates (see patent claims 79-88).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the coatings claimed in the above Patents to conventional substrates such as metals, plastics, polyvinyl chloride, etc. (claim 18-19) in order to form useful articles with stain resistant surfaces such as dry erase surfaces or wall coverings (claims 20-21). One of ordinary skill in the art would have adjusted the curing conditions of the coating (claim 22) depending on the specific curing characteristics of a given coating formulation and the thermal stability or resistance of the substrate to be coated. It would have been obvious to utilize known melamine-based curing resins (claims 6-7) in the above coating compositions depending on the specific curing characteristics required for specific applications and substrates; and the physical properties desired in the resultant end product.

6. The provisional rejections under the judicially created doctrine of obviousness-type double patenting based on copending Application No. 10/492,472 (US 2004/0219378) has been withdrawn upon reconsideration.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7, 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by:

(a) WEINERT ET AL (US 6,383,651); or

(b) CALLICOTT ET AL (US 6,423,418); or

(c) WO 99/450079 (WO '079), for the reasons stated in the previous Office Action.

The above references each disclose curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and methods of forming such coated substrates, wherein the substrate is polyvinyl chloride, the coated substrates are dry erase materials and/or wall coverings, and wherein curing takes place at 150 F or more. (WO '079, see entire document) (CALLICOTT ET AL, see entire document) (WEINERT ET AL '651, see entire document, for example columns 2-7).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-7, 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) WEINERT ET AL (US 6,383,651); or

(b) CALLICOTT ET AL (US 6,423,418); or

(c) WO 99/450079 (WO '079), for the reasons stated in the previous Office Action.

Claims 1-7, 12-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by WEINERT ET AL '651 or CALLICOTT ET AL '418 or WO '079 as stated above. However, in the event the claims are not anticipated, the claims are obvious for the following reasons:

The above references each disclose curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and methods of forming such coated substrates, wherein the substrate is polyvinyl chloride, the coated substrates are dry erase materials and/or wall coverings, and wherein curing takes place at 150 F or more. (WO '079, see entire document) (CALLICOTT ET AL, see entire document) (WEINERT ET AL '651, see entire document, for example columns 2-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the coatings disclosed in the above references to conventional substrates such as metals, plastics, polyvinyl chloride, etc. in order to form useful articles with stain resistant surfaces such as dry erase surfaces or wall coverings (claims 20-21). One of ordinary skill in the art would have adjusted the curing conditions of the coating (claim 22) depending on the specific curing characteristics of a given coating formulation and the thermal stability or resistance of the substrate to be coated.

Response to Arguments

11. Applicant's arguments filed 6/30/2006 have been fully considered but they are not persuasive.

(A) Applicant argues that claims 1-7, 12-22 are entitled to the priority date of 3/5/1998 because Application No. 09/035,595 provides support for the present claims. However, the priority document only provides support for a specific type of ether segment derived from fluorinated oxetane monomer, but does not provide support for other types of ether-containing segments (containing larger numbers of carbons, multiple ether groups, etc.). Therefore, the present claims 1-7, 12-22 are not entitled to the priority date of 3/5/1998.

(B) Applicant argues that U.S. Patent No. 6,660,828 fails to claim the recited invention. However, claims 79-88 of said patent discloses a coating composition as claimed, comprising a polyester with polyether segments with pendent fluorinated moieties, and optionally an amino resin.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 30, 2006

Vivian Chen
Primary Examiner
Art Unit 1773